

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RUDOLF J. DAMS

Appeal No. 1997-2193
Application 07/986,648¹

ON BRIEF

Before METZ, GARRIS and WALTZ, ***Administrative Patent Judges.***

METZ, ***Administrative Patent Judge.***

DECISION ON APPEAL

This is an appeal from the examiner's refusal to allow claims 1 through 14 and 17, all the claims remaining in the instant application.

THE INVENTION

¹ Application for patent filed December 8, 1992.

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The appealed subject matter is directed to a genus of compounds which are fluoroaliphatic sulfonamides. According to appellants the compounds are useful as anionic surfactants.

Claims 1 and 2 are believed to be adequately representative of the appealed subject matter and are reproduced below for a more facile understanding of appellant's invention.

Claim 1. A fluoroaliphatic radical-containing sulfonamido compound which comprises a fluoroaliphatic radical-containing sulfonamido group and an ethylenecarbonyl group whose beta ethylene carbon atom is bonded to a sulfur or nitrogen atom which is bonded to a linking group bonded to the nitrogen atom of said sulfonamido group, and the carbonyl carbon atom of said carbonyl is bonded to an anionic hydrophilic polar group comprising at least one carbon, nitrogen, oxygen, or sulfur atom.

Claim 2. The fluoroaliphatic radical-containing sulfonamido compound of claim 1 wherein said compound has the formula



where R_f is a fluoroaliphatic radical; A is S or NR''' ; W is siloxylene, silylene, alkylene, arylene, or combinations thereof; R , R' , R'' , R''' are independently hydrogen, lower alkyl, aryl, or combinations thereof, and can contain functional groups, or R and R''' together

² "W", the universally accepted symbol for tungsten, and "Y", the universally accepted symbol for yttrium, do not have their universally accepted meaning in appellants' claims.

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with the nitrogen atoms to which they are bonded and **W**, form a ring; and **Y** is an anionic hydrophilic polar group comprising at least one carbon, nitrogen, oxygen, or sulfur atom.

THE REJECTIONS

It is difficult from the record for us to state with precision exactly what rejections the examiner has maintained and from which rejections appellants appeal. In Paper Number 15, the examiner: rejected claims 1 through 14 and 17 under 35 U.S.C. § 112, second paragraph; rejected claims 1 through 14 and 17 "as being drawn to improper Markush group including patentably distinct members"; objected to the specification under 35 U.S.C.

§ 112, first paragraph, as non-enabling and then rejected claims 1 through 14 and 17 under the same section of the statute and further relied on the Manual of Patent Examining Procedure (MPEP) §§ 706.03(n) and 706.03(z) in support of that rejection; rejected claims 1 through 14 and 17 under 35 U.S.C. § 103 as unpatentable from Dear et al. considered with Groves and Muller or over Hoechst, alone; rejected claim 1 under 35 U.S.C. § 112, first and second paragraphs; and, rejected claim 17 for the reasons claim 1 was rejected under both first and second paragraph of 35 U.S.C. § 112 and additionally as a

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"duplicate of claim 1."

In the final rejection (Paper Number 17), the examiner: specifically withdrew the prior art rejections; withdrew the rejection of claims 1 through 14 and 17 under 35 U.S.C. § 112, second paragraph, to the extent the rejection was based on the claim language "linking group" and "aryl"; maintained "the rejection of claims 1-6 (in part), 9, 10-14 and 17 under 35 U.S.C. 112, first paragraph, ... for the reasons cited"; appears to have maintained the rejection of the claims as including an improper Markush group; maintained the rejection of claim 17; and, appears to have stated a new reason (lack of antecedent basis for "substituted piperazine ring") for finding claim 3 is unpatentable.

In his advisory action (Paper Number 19), the examiner, after acknowledging appellants' response to the final rejection: explained that the rejection of claims 1 through 14 and 17 under 35 U.S.C. § 112, second paragraph, "of paper #15, mailed on 02/16/95 is maintained, for the reasons cited therein; except for issues 1), 3), 7) on pages 2, 3 and 4" and further explained that "[s]imilar rejection under the same statute is also maintained for issues (A), (B), (C), (D), (E) and (F) on pages 10 and 11 of the same paper #15"; maintained

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the rejection of claims 1 through 6, 9 through 14 and 17 under 35 U.S.C. § 112, first paragraph; maintained the rejection of all the claims as "based on an improper Markush"; maintained the rejection of claim 17 as a "substantial duplicate of claim 1"; and, restated his previously stated position that "[t]he unknown substitutents on the piperazine of claim 3 are not presented."

In his Answer (Paper Number 22), the examiner has stated under the heading "Grounds of rejection" that the rejections before us are the rejections of claims 1 through 14 as they are founded on the examiner's stated objection to the specification. Nevertheless, under heading "Response to argument", the examiner repeats his previously stated rejection of claim 6 as drawn to an "improper Markush" and restates his previously stated rejections of claims 17 ("body of liquid") and 3 ("substituted piperazine ring").

To appellants' credit, notwithstanding the confused prosecution of this application and the examiner's poorly organized Answer, it appears appellants have addressed all the examiner's rejections and underlying reasons for the rejections as set forth in paper numbers 15, 17, 19 and 22.

OPINION

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In In re Moore, 439 F.2d 1232, 169 USPQ 236 (CCPA 1971), one of the predecessors to our reviewing court enunciated the test for determining whether or not an application for patent complied with the requirements of 35 U.S.C. § 112, first paragraph. As the court noted, In re Moore, 439 F.2d at 1235, 169 USPQ at 238:

Any analysis in this regard should begin with the determination of whether the claims satisfy the requirements of the second paragraph. It may appear awkward at first to consider the two paragraphs in inverse order but it should be realized that when the first paragraph speaks of "the invention", it can only be referring to that invention which the applicant wishes to have protected by the patent grant, i.e., the *claimed* invention. For this reason the claims must be analyzed first in order to determine exactly what subject matter they encompass. The subject matter there set out must be presumed, in the absence of evidence to the contrary, to be that "which the applicant regards as his invention.

Thus, it is clear the examiner, in the first instance, must analyze the claims for compliance with paragraph 2 of the statute before addressing questions arising under the first paragraph of the statute.

Accordingly, before the examiner addressed the question of whether or not appellants' disclosure was enabling for the claimed subject matter, the examiner should have first ascertained the metes and bounds of the claim terminology as

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it is defined by appellants in their disclosure and as said terminology would have been understood by a person of ordinary skill in the art. Rather than ascertaining the metes and bounds of the claimed compounds by reference to the specification and the definitions of the claim terminology found therein, the examiner has focused on individual claim terms, in a vacuum, without regard to their meaning as defined in the disclosure and without regard to the context of their meaning in the claimed compounds considered as a whole. The examiner's stated positions with regard to appellants' alleged failure to comply with paragraph 2 of the statute are founded on speculation and conjecture rather than objective evidence which supports the positions taken by him.

Admittedly, the claims are of considerable scope; however, this, in and of itself, is not a basis for rejection. U.S. Steel Corp. v. Phillips Petroleum Co., 865 F.2d 1247, 1251, 9 USPQ2d 1461, 1464 (Fed. Cir. 1989). As the court suggested in In re Borkowski, 422 F.2d 904, 910, 164 USPQ 642, 646 (CCPA 1970), the proper approach to take when claims are found to be considerable in scope is to reject such claims on prior art, not reject them under the second paragraph of the statute.

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It is also generally understood that an applicant for patent may be his own lexicographer so long as an applicant for patent clearly sets forth in applicant's specification the definition applicant intends for a particular claim term, even when that definition is different from the conventional, art-recognized definition. Beachcombers, Int. v. WildeWood Creative Products, Inc., 31 F.3d 1154, 1158, 31 USPQ2d 1653, 1656 (Fed. Cir. 1994); ZMI Corp. v. Cardiac Resuscitator Corp., 844 F.2d 1576, 1579, 6 USPQ2d 1557, 1560 (Fed. Cir. 1988); Envirotech Corp. v. Al George, Inc., 730 F.2d 753, 759, 221 USPQ 473, 477 (Fed. Cir. 1984).

It is incumbent upon the examiner in making a rejection under the first paragraph of 35 U.S.C. § 112, to make out a *prima facie* case of lack of enablement. In re Strahilevitz, 668 F.2d 1229, 1232, 212 USPQ 561, 563 (CCPA 1982); In re Wertheim, 541 F.2d 257, 263, 191 USPQ 90, 97 (CCPA 1976); In re Armbruster, 512 F.2d 676, 677, 678, 185 USPQ 152, 153 (CCPA 1975); In re Marzocchi, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). Moreover, in determining whether or not a disclosure is enabling, it has been consistently held that the enablement requirement of the first paragraph of 35 U.S.C. § 112 requires nothing more than objective enablement. In re

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Marzocchi, 439 F.2d at 223, 169 USPQ at 369. In meeting the enablement requirement, an application need not teach, and preferably omits, that which is well-known in the art.

Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986).

We recognize that the enablement requirement of the first paragraph of 35 U.S.C. § 112 requires that there be some reasonable correlation between the scope of the claims and the scope of enablement described in the specification. In re Fisher, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970).

However, how such a teaching is set forth, whether by the use of illustrative examples or by broad descriptive terminology, is of no importance since a specification which teaches how to make and use the invention in terms which correspond in scope to the claims must be taken as complying with the first paragraph of 35 U.S.C. § 112 unless there is reason to doubt the objective truth of the statements relied upon therein for enabling support. Marzocchi at 439 F.2d 223, 169 USPQ 369.

Based on this record, the examiner has failed to present evidence establishing that appellants' disclosure is insufficient compared to the scope of their claims. The examiner has presented only conjecture and no objective

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evidence in support of the position taken by him in support of his rejection.

We remind the examiner that it is the function of the specification, not that of the claims, to set forth the practical limits of operation of an invention. In re Johnson, 558 F.2d 1008, 1017, 194 USPQ 187, 195 (CCPA 1977). Further, in Johnson the court reminded the board that the language in an appellants' claims must be read in light of the specification as the specification would be interpreted by one of ordinary skill in the art and not in a vacuum. Johnson, 558 F.2d at 1016, 194 USPQ at 194.

To the extent the examiner's rejection is founded on an alleged lack of an adequate written description of what is now claimed by appellants, the question to be resolved concerning the "written description" requirement of 35 U.S.C. § 112, first paragraph, is whether or not appellants' original disclosure reasonably conveyed that they were possessed of, as of their filing date, the invention later claimed by them. The primary inquiry into satisfaction of the written description requirement is factual and depends on the nature of the invention and the amount of knowledge imparted to those

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skilled in the art by the disclosure. Wertheim, 541 F.2d at 262, 191 USPQ at 96. We find appellants have satisfied the written description requirement of 35 U.S.C. § 112, first paragraph.

THE IMPROPER MARKUSH REJECTION

The examiner bases his rejection of the claims as being drawn to an improper Markush group in part on the decision in In re Harnisch, 631 F.2d 716, 206 USPQ 300 (CCPA 1980).

However, we first note that in Harnisch, 631 F.2d at 720, 206 USPQ at 304, the court specifically held that:

"there is no "doctrine" to be considered but only a body of case law emanating from both "higher" and "lower" authority, not altogether consistent, the latest decisions tending to carry the most weight as precedent."

Notwithstanding this holding, the court did recognize the possibility that there could be such a thing as an improper Markush group and further recognized that each case involving the propriety of a Markush group must be considered on its own facts, and cited In re Jones, 162 F.2d 479, 74 USPQ 149 (CCPA 1947) in support of its conclusion. Thus, we must determine if the examiner's factual determinations with respect to the claimed "Markush group" are sound and, if sound, whether or not they give rise to the conclusions made by the examiner.

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We find, contrary to the examiner's conclusion, that the claimed compounds do possess a common structural feature disclosed as essential to the disclosed utility of being an anionic surfactant. Rather than consider the compound as a whole, the examiner has focused on the individual moiety defined by the Markush terminology. As can be seen from claim 6, the Markush terminology defines the moiety **N(R)WA** and the question to be decided is whether the compounds defined by the different moieties have so-called common structural features and common utilities.

Suffice it to say, the examiner has not even addressed this issue but has instead merely pronounced that the members of the Markush group are allegedly separately classifiable and separately patentable. We observe that the first action by the examiner in this application was to require restriction and in so-restricting the claims, at that time, the examiner did not consider the subject matter he now finds improperly joined to be subject to restriction. Under these circumstances, the examiner should have made a new requirement for restriction if he could present the necessary underlying evidence to support such a requirement. Based on this record,

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the examiner has simply not substantiated by presentation of objective evidence or scientific argument that any compound within the broad description which comprises the "Markush group" would not possess utility as an anionic surfactant as alleged by appellants.

CLAIM 17

Claim 17 is, obviously, not a duplicate of claim 1. Claim 1 is directed to a compound. Claim 17, as we understand the claim, is directed to the combination of the compound in a liquid. As such, claim 17 is understood to be a composition claim. Thus, a person could make the invention of claim 1 without practicing the subject matter of claim 17. The rejection is **reversed**.

CLAIM 3

To the extent we understand the examiner's position with respect to claim 3, we **reverse**. It seems apparent to this panel that the "substitutents" on the piperazine ring must depend on the nature of **R** and **R'''** which together with the nitrogen atoms and **W** form the piperazine ring.

SUMMARY

The decision of the examiner rejecting appellants' claims

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under 35 U.S.C. § 112 is reversed. The decision of the examiner rejecting the claims as directed to an "improper Markush" is reversed. The rejection of claim 17 as a duplicate of claim 1 is reversed. The rejection of claim 3 is reversed.

The decision of the examiner is REVERSED.

REVERSED.

ANDREW H. METZ)	
Administrative Patent Judge)	
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BRADLEY R. GARRIS)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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THOMAS A. WALTZ)	
Administrative Patent Judge)	

AHM/gjh

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